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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,201	12/18/2000	Cian E. O'Meara	920673-907251	4327
23644 7590 10/14/2010 BARNES & THORNBURG LLP One North Wacker Drive CHICAGO, IL 60690-2786				
EXAMINER BOYCE, ANDRE D				
ART UNIT 3623		PAPER NUMBER		
NOTIFICATION DATE 10/14/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

# Office Action Summary

**Application No.**

09/740,201

**Applicant(s)**

O'MEARA ET AL.

**Examiner**

Andre Boyce

**Art Unit**

3623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-29 and 36 is/are allowed.
- 6) ☒ Claim(s) 1-23 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Final office action is in response to Applicant's amendment filed 8/2/10.

Claim 1 has been amended. Claims 1-29, 35 and 36 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1-23 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101 *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010). The rationale for this finding is explained below:

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing.

With respect to independent claims 1 and 23, the claim language recites the steps of maintaining a current order, maintaining a prioritized listing, receiving said location-based order, updating said current order, etc. Here, there is insufficient recitation of a machine or transformation, and/or wherein involvement of machine, or transformation with the steps is merely nominally, insignificantly, or tangentially

related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied.

In addition to the discussion in the BPAI decision filed 11/6/09, on pages 16-17, not included here for brevity, but still applicable, the recitation "said method being carried out by an ordering server programmed to carry out the steps of the method," has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 2-22 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

4. Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 35 recites "[a] computer program product comprising a physical data carrier in machine readable form..." The broadest reasonable interpretation of a claim drawn to a computer program product typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification

is silent (as is Applicant's specification), or open-ended. Moreover, the term "physical," which does not appear in Applicant's specification, may be defined as "of or relating to natural science or physics" (Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1999). As such, the claim is rejected as covering a signal per se, which is not directed towards statutory subject matter. See MPEP 2111.01.

***Allowable Subject Matter***

5. Claims 24-29 and 36 are allowed.

***Response to Arguments***

6. In the Remarks, Applicant argues the rejection is traversed on two grounds: firstly, that claims 1 and 35 do in fact satisfy the "machine or transformation test"; and secondly, that a rejection solely based on the "machine or transformation test" fails to address the proper enquiry which has since been set forth in the recent Supreme Court Decision *Bilski v. Kappos*, No. 08-964 (June 28, 2010). The Examiner respectfully disagrees.

As an initial note, the Examiner submits that Applicant has failed to address the outstanding 35 USC § 101 rejection of independent claim 23, as raised in the previous Office Action and currently maintained. Technically, Applicant's amendment is non-compliant for failing to address the rejection, however the Examiner assumes it was a simple oversight.

With respect to claim 35, Applicant's arguments are misguided and incorrect. As Applicant is most likely aware, Bilski is concerned with process or method claims, and as a result Applicant's Bilski based arguments do not apply to claim 35, because the claim is not a process or method claim, but rather a computer program product claim.

Lastly, as discussed above, claim 1 is considered non-statutory, wherein the ordering server is contained in the preamble of the claim.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/  
Primary Examiner, Art Unit 3623  
October 8, 2010